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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,116	01/12/2001	Brian T. Jordan	IP105.1	7316

23470 7590 03/26/2003

SRAM CORPORATION  
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CHICAGO, IL 60622

EXAMINER

MCANULTY, TIMOTHY P

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/681,116

Applicant(s)

JORDAN, BRIAN T.

Examiner

Timothy P McAnulty

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 09 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 09 January 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) Paper No. 7, filed 07 October 2002 contains reference US Patent No. 5,728,017 to Bellio et al. which was previously cited in the IDS filed 29 January 2001 and US Patent No. 5,261,858 to Browning which was previously cited in form PTO-892 as part of Paper No. 6, mailed 09 October 2002. Accordingly, US Patent No. 5,728,017 to Bellio et al. and US Patent No. 5,261,858 to Browning have been previously considered and thus have been lined through in the IDS filed 07 October 2002.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer et al. Spencer et al. discloses in figures 1,2,21-27, in lines 28-42 of column 6, and in lines 52-63 of column 14 a gear shifting system for a bicycle transmission which operates in three modes, a manual mode, an automatic mode, and a learning mode wherein control of the transmission

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comprises actuating a controller to enter the learning mode in which a rider manual shifts the bicycle transmission through selected gears; storing bicycle speeds for the selected gears associated with the manual shifts; the controller defining speed ranges for the selected gears; automatically shifting the bicycle transmission when operating in the automatic mode by measuring a current bicycle speed; determining a current gear of the bicycle transmission; comparing the current bicycle speed with a defined speed range for the current gear; and shifting the bicycle transmission from the current gear to another gear when the bicycle speed is outside the defined speed range for the current gear. The gear shift system in addition to the controller 21 comprises a wheel speed input 23; a gear control output 32,33; a display 31 which Spencer et al. further discloses in lines 32-41 of column 3 displays at least the current bicycle speed and/or the selected gear; a mode selector; a shifter; and a memory 22 on which a computer program is recorded.

Spencer et al. discloses the basic apparatus except for automatically shifting the bicycle transmission when operating in the automatic mode by using only bicycle speed. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to eliminate parameters other than bicycle speed for bicycle transmission shifting, since omission of an element and its function where not needed is obvious to one of ordinary skill in the art. *Ex parte Rainu*, 168 USPQ 375 (PTO Bd. of App. 1969). Subject matter is not patentable in absence of showing unexpected result[s] flowing from such omission. *In re Wilson*, 153 USPQ 740 (CCPA 1967).

Regarding claims 5,12, and 27, shifting the bicycle transmission into the lowest gear upon actuation of the setting mode would be inherent so that all of the gears of the bicycle

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transmission will be manually selected during the setting mode thus ensuring a speed range is defined for all selectable gears.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection. Although Spencer et al. discloses a gear shifting mechanism for automatically shifting gears of a bicycle transmission based on bicycle speed, drive rate, torque transmitting member tension, vehicle inclination, and gear changer position, the omission of the above parameters except for bicycle speed when not necessary to the shifting of the bicycle transmission is obvious to one of ordinary skill in the art.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art regarding automatic bicycle transmissions in general:

US Patent No. 6,352,486 B1 to Westling

US Patent No. 5,254,044 to Anderson

US Patent No. 4,605,240 to Clem et al.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

tpm   
March 20, 2003

 3/20/03  
William C. Joyce  
Patent Examiner